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In re Application of
Scott A. Burton et al
Serial No.: 10/729,114
Filed: December 5, 2003
Attorney Docket No.: 59098US002

PETITION DECISION

This is in response to the petition under 37 CFR 1.144, filed November 1, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on December 5, 2003, and contained claims 1-23. In a first Office action, mailed April 12, 2007, the examiner required restriction, as follows:

Group I – claims 1-18 and 21, drawn to a wound dressing comprising substrate, polymer matrix and microparticles;

Group II – claims 19 and 22, drawn to a wound dressing comprising substrate, polymer matrix of styrene-isoprene-styrene and microparticles; and

Group III – claims 20 and 23, drawn to a wound dressing comprising substrate, polymer matrix comprising styrene-isoprene-styrene polymer and microparticles of sodium polyacrylate copolymer.

The examiner reasoned that the Groups were directed to different articles based on their differing compositions and other limitations.

Applicants replied on May 8, 2007, electing the compounds of Group I with traverse and argued that Groups II and III were encompassed within generic Group I and should be rejoined therewith.

The examiner mailed a new Office action to applicants on July 20, 2007, acknowledging the election of Group I with traverse, but maintaining the requirement, and making it Final. The examiner argued that the Groups were distinct in not requiring the same limitations and searching all would place an undue burden on the Office. Claims 19-20 and 22-23 were withdrawn from consideration. The examiner then rejected claims 1-23 for obvious double

patenting over SN 10/728,577. Claims 4-6, 14 and 16 were then rejected under 35 U.S.C. 112, second paragraph, as indefinite for various reasons. Claims 1-6, 13-18 and 21 were rejected under 35 U.S.C. 102(b) as anticipated by WO 02/066087. Claims 7-8 were rejected under 35 U.S.C. 103(a) as unpatentable over WO '087 alone and claims 9-11 over WO '087 in view of Salcare and claim 12 over WO '087 in view of US 4,902,585.

Applicants replied to the Office action on October 22, 2007, amending claims 4-6 and addressing all of the rejections of record. This petition was filed on November 1, 2007, requesting withdrawal of an improper restriction requirement.

DISCUSSION

Applicant traverses the restriction requirement on the basis that claim 1 and Group I is generic to claims 19 and 20 (Groups II and III, respectively) since they merely include combinations of limitations from claims dependent on claim 1 and would have to be encompassed within a search of the claims of Group I.

A review of the claims shows that claim 1 is directed to a wound dressing comprised of three parts: 1) a hydrophobic organic polymer matrix; 2) an optional plasticizing agent; and 3) a hydrophilic organic microparticle. Claim 2 defines the polymer matrix as styrene-isoprene-styrene and others. Claims 9-11 define the microparticle as being an amine containing organic polymer, specifically a methacrylate. Claim 19 is also to a wound dressing comprised of a styrene-isoprene-styrene copolymer and others, an optional plasticizing agent and a microparticle which is an amine containing organic polymer. Claims 20 is identical to claim 19 except that the microparticle is an acrylate. Thus the narrower limitations of claims 19 and 20 are also limitations found in claims dependent on claim 1. The examiner's argument that claims 19 and 20 do not have the particle sizes, porosity, etc., of the claims of Group I is invalid since claim 1 has no such limitations. Additionally, since all three Groups are classified in the same class and subclass there can be no undue burden on the Office for searching.

In view of the above the restriction requirement is withdrawn and all claims will be examined.

DECISION

The petition is **GRANTED** as set forth above.

The application will be forwarded to the examiner for consideration of applicants' reply filed October 22, 2007, and further action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

